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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,554	11/28/2001	Huub Van Aert	27500-13	2836

7590 10/21/2003

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EXAMINER

FUNK, STEPHEN R

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/996,554	AERT ET AL.	
	Examiner	Art Unit	
	Stephen R Funk	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. However, it is noted that priority application EP 00000003.4 filed on 12/20/2000 does not provide support for the claimed invention, in particular, the limitation in claim 1 of increasing the run length by a factor of 5 when reducing the particle size of the polymer particles. For example, compare the last several pages of the instant specification with the last several pages of the priority *application*, not the published document (EP 1 219 416).

The substitute specification filed August 29, 2003 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: There is no substitute specification in clean form. Furthermore, the proposed marked-up copy still contains several errors. Note, for example, the grammatical and/or typographical errors on proposed page 11 lines 5 and 8 and page 47 last line.

The abstract of the disclosure is objected to because it contains the legal phraseology "said". Correction is required. See MPEP § 608.01(b).

Claims 1 - 8 are objected to because of the following informalities:

In claim 1, page 60 line 2, "are containing" should be corrected.

In claim 2 line 3 "containing" should presumably be --contain--.

In claim 5 line 2 "thermoplastic" is misspelled.

Appropriate correction is required.

Claims 14 - 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

First, there is no support in the disclosure for the “dampening liquid comprising ink” as is recited in claim 14 or the “ink comprising a dampening liquid” as is recited in claim 17. First, the terminology of one “comprising” the other is repugnant to its normal meaning as dampening liquid and ink are usually mutually exclusive (unless applied as an emulsion which is addressed immediately below). Second, disclosure in the specification of “applying an aqueous dampening liquid and/or ink” does not state that the dampening liquid and ink are mixed as an emulsion unless specifically disclosed as such. One of ordinary skill in the art would interpret this phrase that either dampening liquid can be applied, ink can be applied, or both dampening liquid and ink can be applied sequentially, not mixed together.

Second, there is no support in the disclosure for “applying an aqueous ink” as is recited in claim 15. Again, the disclosure in the specification of “applying an aqueous dampening liquid and/or ink” does not state that the ink may be aqueous, only that the dampening liquid may be aqueous. Applicant provides no support for printing with an aqueous ink or how such printing would be accomplished. The mere fact that one of ordinary skill in the art may be able to print with an aqueous ink does not enable applicant’s disclosure, particularly in view of the lack of any description whatsoever of printing with an aqueous ink.

Third, there is no support in the disclosure for “printing at least 5 times faster” as is recited in claim 15. The disclosure of providing a “printing run length increased by a factor of 5” does not equate to printing faster, only longer.

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Claims 1 - 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 lines 16 - 20 the phrase "being a range ... providing said reference run length" has no clear meaning. In particular, the meaning of the recitation "the same reduction" is not clear in context. The phrase will be interpreted as the range is the same for the printing run length and the reference run length.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 - 5, 8, and 12 - 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al. (EP 849 091) in view of Vermeersch et al. (EP 770 494). Van Damme et al. teach a method of image-wise exposing (page 5 lines 20 - 23) a heat sensitive imaging element comprising a lithographic base with a hydrophilic surface (page 4 lines 28 - 33), an image forming layer including hydrophobic thermoplastic polymer particles in a hydrophilic binder wherein the particles have an average size diameter in the range from 0.015 to 0.15 μm (page 3 lines 30 - 41), developing the exposed imaging element on the printing press (page 5

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lines 20 - 23), and starting printing. Although Van Damme et al. do not specifically teach that the styrene or methylmethacrylate (page 3 line 55) have more than 0.1 wt % of nitrogen, applicant appears to disclose in the specification and uses the closed terminology “consist of” in claim 4 line 3 to indicate that styrene and methylmethacrylate have the recited content of nitrogen. It is noted that the recitation of a reference run length in the preamble of claim 1 does not limit the positively recited method steps in the body of the claim. Furthermore, the recitation of “starting printing up to the increased run length” would be inherent, or at least obvious, in view of the increased durability achievable by utilizing styrene or methylmethacrylate. Van Damme et al. do not specifically teach developing the exposed imaging element by applying an aqueous dampening liquid and/or ink. Vermeersch et al. teach the conventionality of developing an exposed imaging element by such. See the Abstract of Vermeersch et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Van Damme et al. with the step of developing the exposed imaging element by applying an aqueous dampening liquid and/or ink in view of Vermeersch et al. so as to more quickly and easily develop the imaging element.

With respect to claim 3 see page 4 line 57+ of Van Damme et al.

With respect to claim 4 see page 3 line 55 of Van Damme et al. Applicant’s use of closed terminology that the polymer particles “consist of” a homopolymer or copolymer of styrene or methylmethacrylate necessitates that these two polymers have the recited nitrogen content.

With respect to claim 5 see page 4 lines 7 - 8 of Van Damme et al.

With respect to claim 8 see page 4 line 28+ of Van Damme et al.

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With respect to claim 12 Van Damme et al. in view of Vermeersch et al. teach the method as recited as indicated above.

With respect to claim 13 see page 5 lines 20 - 21 of Van Damme et al.

With respect to claim 14 insofar as applicant's disclosure of "applying an aqueous dampening liquid and/or ink" supports the recitation of the dampening liquid comprising ink so would such a recitation in the prior art.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al. in view of Vermeersch et al. as applied to the claims above, and further in view of Leenders et al. (US 6,030,765). Van Damme et al. do not teach the polymer particle comprising one of the recited polymers of claim 2. Leenders et al. teach the conventionality of polymer particles comprising urethane. See column 4 lines 15 - 20 of Leenders et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Van Damme et al., as modified by Vermeersch et al., with urethane polymer particles in view of Leenders et al. to achieve the benefits expected from using urethane. Again, applicant's disclosure appears to disclose that urethane has the recited nitrogen content.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al. in view of Vermeersch et al. as applied to the claims above, and further in view of Vrancken et al. (US 4,004,924). Van Damme et al. do not teach a second layer having a hydrophilic polymer binder. Vrancken et al. teach the conventionality of a second layer (9, 8) having a hydrophilic polymer binder (5). See Figures 4 - 6 and column 4 line 56 - column 5 line 40 of Vrancken et al. It would have been obvious to one of ordinary skill in the art to provide the method of Van

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Damme et al., as modified by Vermeersch et al., with a second hydrophilic polymer layer in view of Vrancken et al. to more easily apply infrared absorbing compounds to the imaging element.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al. in view of Vermeersch et al. as applied to the claims above, and further in view of Vermeersch et al. (EP 931 647). Van Damme et al. do not teach the infrared absorbing compound. Vermeersch et al. teach the conventionality of an anionic infrared cyanine dye. See the Abstract and paragraphs [0015] - [0017] of Vermeersch et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Van Damme et al., as modified by Vermeersch et al., with an anionic infrared cyanine dye in view of Vermeersch et al. to provide higher infrared sensitivity.

Claims 9 - 11 have been canceled.

Claims 15 - 17 cannot be accurately examined with respect to the prior art at this time due to the lack of support in the disclosure for the recitation "faster" as addressed above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (703) 308-0982.

The examiner can normally be reached from 7:30am to 6:00pm, except Wednesdays.

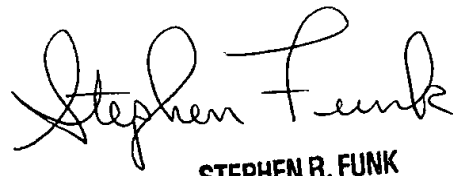
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached on (703) 305-6619.

The fax phone number for *official* papers is (703) 872-9306. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

SRF
October 15, 2003



STEPHEN R. FUNK
PRIMARY EXAMINER